

REMARKS

Claims 11-13 are now pending in this application for which applicant seeks reconsideration.

Amendment

Claims 1-10 have been canceled in favor of new claims 11-13. Note that the method steps set forth in claim 13 are tied to the image forming apparatus (e.g., 100) and the information processing apparatus (e.g., 302) thus obviating the § 101 rejection. Moreover, the Supreme Court, in *Bilski et al v. David Kappos*, Supreme Court No. 08-964, 28 June 2010, soundly rejected the Federal Circuit's (and USPTO's) *machine-or-transformation test* for determining § 101 subject matter in a method claim. No new matter has been introduced.

Art Rejection

Claims 1-6 and 8-10 were rejected under 35 U.S.C. § 102(b) as anticipated by Nakamura (USPGP 2002/0143568), and claim 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nakamura in view of Quistgaar (USPGP 2003/0009102).

First, applicant submits that the examiner's claim construction, regarding language "that stores," "that permits," "that acquires" relating to functional language that need not be given patentable weight, is improper. As applicant had already explained, these limitations are indeed structural due to the software-hardware features. Moreover, given the new CAFC case, *In re Suitco Surface, Inc.*, 2009-1418 (Reexamination no 90/007,015), decided 14 April 2010, applicant submits that the examiner's claim construction is improper even if the above limitations were deemed functional as urged by the examiner.

Specifically, in the new CAFC case, the claim language at issue was *improved material for finishing the top surface of the floor*. The USPTO interpreted the above limitation to include anything that falls "anywhere above the surface ... regardless of whether it actually 'finishes' the surface. Basically the USPTO ignored the limitation "for finishing the top surface of the floor." The CAFC held that although the USPTO is required to give all claims their broadest reasonable construction, the claim construction must be consistent with the specification. Indeed, the broadest-construction rubric does not give the USPTO an unfettered license to interpret the claims to embrace anything remotely related to the claimed invention. Indeed, the examiner must consider all limitations of the claims, and cannot conveniently ignore those limitations deemed by the examiner to be functional.

Second new independent 11 now calls for an image forming apparatus having the following features:

- (1) a storage unit adapted to obtain, from an external apparatus, license information of the program module and store the license information, the license information including a total number of print surfaces the program module is allowed to process and a total number of original surfaces the program module is allowed to process (see paragraph 108, step S1408 in Fig. 15);
- (2) a counting unit adapted to count up values of used resources of the program module, the values being managed in a table (see paragraph 119, and Fig. 19), wherein when the program module controls the scanner engine to carry out the scanning process, the counting unit counts up a total number of original surfaces scanned, while when the program module controls the printer engine to carry out the printing process, the counting unit counts up a total number of print surfaces printed in the printing process (see paragraph 124-126 and Fig. 19);
- (3) a determining unit adapted to determine that the license information is invalid when the total count value of the surfaces scanned by the scanning process counted up by the counting unit exceeds the total number of the original surfaces included in the license information or when the total count value of the surfaces printed by the printing process counted up by the counting unit exceeds the total number of print surfaces included in the license information (see paragraph 136-139, and steps S2103, S2105 in Fig. 22); and
- (4) a changing unit adapted to change a setting for starting the program module so that the program module does not start when the controller of the image forming apparatus is started, in the case where the determining unit determines that the license information is invalid to disable the program module (see paragraph 138 and step S2106 in Fig. 22).

New independent 12 calls for a license managing system comprising an information processing apparatus (e.g., 102) and image forming apparatus (e.g., 100) having a controller and a program module adapted to control a scanner engine and a printer engine.

The information processing apparatus has the following features:

- (5) a setting unit adapted to set a licensing condition as a condition of the program module installed in the image forming apparatus (see paragraph 89);
- (6) an encrypting unit adapted to encrypt the licensing condition set by the setting unit using a public key to generate license information, including information for identifying the

program module installed in the image forming apparatus, apparatus identifying information for identifying the image forming apparatus, and the encrypted licensing condition (see paragraphs 86-87 and Fig. 10), wherein the license information further includes a total number of print surfaces the program module is allowed to process and a total number of original surfaces the program module is allowed to process (see paragraphs 78-81 and Fig. 18); and

- (7) a first storage unit adapted to store the license information (see paragraph 92);
The image forming apparatus has the following features:
- (8) a designating unit adapted to receive an instruction from a user to designate a storage destination of the license information stored in the first storage unit based on the received instruction (see paragraphs 102-103 and Fig. 13);
- (9) an obtaining unit adapted to obtain based on the designated storage destination, the license information from the information processing apparatus (see paragraph 108 and step S1405 in Fig. 15);
- (10) a decrypting unit adapted to decrypt the encrypted licensing condition included in the license information stored in the first storage unit using a secret key (see paragraph 112);
- (11) a second storage unit adapted to store the license information including the decrypted licensing condition (paragraph 108 and step S1405 in Fig. 15);
- (12) a changing unit adapted to change a setting for starting the program module so that the program module starts when the controller of the image forming apparatus is started, in the case where the apparatus identifying information included in the license information stored in the second storage unit identifies the image forming apparatus, and the information for identifying the program module included in the license information identifies the program module installed in the image forming apparatus (see paragraphs 112-116 and steps 1503-1505 in Fig. 16);
- (13) a counting unit adapted to count up, when the changing unit changes the setting for starting the program module so that the program module starts when the controller of the image forming apparatus is started, values of used resources of the program module, the values being managed in a table, wherein when the program module controls the scanner engine to carry out the scanning process, the counting unit counts up a total number of original surfaces scanned, while when the program module controls the printer engine to carry out the printing process, the counting unit counts up a total

- number of print surfaces printed in the printing process (see paragraphs 119, 124-126 and Fig. 19); and
- (14) a determining unit adapted to determine that the license information is invalid when the total count value of the surfaces scanned by the scanning process counted up by the counting unit exceeds the total number of the original surfaces included in the license information or when the total count value of the surfaces printed by the printing process counted up by the counting unit exceeds the total number of print surfaces included in the license information (see paragraphs 136-139 and steps S2103, S2105 in Fig. 22); and
 - (15) wherein the changing unit changes the setting for starting the program module so that the program module does not start when the controller of the image forming apparatus is started, in the case where the determining unit determines that the license information is invalid to disable the program module (see paragraph 138 and steps S2105 in Fig. 22).

As claimed, whether to start the program module can be controlled based on the license information received from the external apparatus (e.g., information processing apparatus 302). When the total number of print or scanned surfaces processed by the program module exceeds a predetermined number, the program module is disabled when the controller of the image forming apparatus is started.

Nakamura discloses an image processing apparatus that stores upgradable trial functions (software) that can be started by the user. Nakamura calls for providing termination, extension of a period, etc., of the trial. Nakamura also discloses that when the trial function is activated, a number of copies used in the trial is monitored as client data indicating how often the user uses the trial mode, which data can later aid in provision of services. See paragraph 62. Nakamura does not use the number of copies printed, for instance, for determining whether to disable the trial function. Rather, Nakamura strictly uses the trial period, namely a range of days, regardless of the frequency of use. In this respect, Nakamura does not disclose setting the ending of the trial function according to the number of copies processed during the trial period.

Quistgaard, which was merely relied upon for the encrypting aspect, discloses a portable handheld ultrasound instrument performing both of B-mode image processing and Doppler image processing, and including upgradable software and data of measuring instrument to an updated version or a modified version, using an encrypted keycode. Quistgaard would not have alleviated Nakamura's shortcomings noted above even if the combination were deemed proper

for argument's sake. Quistgaard also fails to disclose counting the number of use of the keycode for the update. Moreover, Quistgaard does not disclose changing the setting for starting the update according to the number of keycode use.

Accordingly, Nakamura and Quistgaard fail to disclose or teach at least the claimed features (3) and (4), (12), (14), and (15) outlined above. Applicant submits that Nakamura and Quistgaard also fail to disclose or teach at least the claimed feature (6) of encrypting the licensing condition set by the setting unit using a public key to generate license information, including information for identifying the program module installed in the image forming apparatus, apparatus identifying information for identifying the image forming apparatus, and the encrypted licensing condition, where the license information further includes a total number of print surfaces the program module is allowed to process and a total number of original surfaces the program module is allowed to process.

Independent claim 13 parallels claim 12.

Conclusion

For the foregoing reasons, applicant submits that claims 11-13 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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19 JULY 2010

DATE

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